

REMARKS

Claims 1-21 and 29 are pending in the application and all stand rejected. The previous amendment and response filed May 23, 2007 to the Final Rejection dated April 6, 2007 was not entered. Therefore, this amendment and response repeats the amendments to the claims of the previous response. As a result, claims 1, 12 and 29 are amended. In addition, claims 2-5, 9, 10, 14-16, 20, and 21 are amended and reformatted for reading simplicity. Entry, reconsideration and allowance of claims 1-21 and 29 is respectfully requested in light of the accompanying Request for Continued Examination and in view of the following remarks:

Responses to Rejection of Claims – 35 U.S.C. § 112

Claims 1, 12 and 29 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for containing the language "and/or". Applicant submits that this rejection is defective and should be withdrawn.

MPEP 706.03(d) discusses claim rejections under 35 USC 112, second paragraph. While many examples of indefinite claim language are given in this section of the MPEP, no mention is found of the phrase "and/or" as being indefinite. It is submitted that the phrase "and/or" is NOT indefinite. For example, the plain meaning of the phrase "A and/or B" means either A and B, or in the alternative, the phrase means A or B. As an example to the validity of this argument, a quick search of the USPTO website revealed that the USPTO has issued 135,036 patents between 1976 and June 26, 2007 with the phrase "and/or" in the claims. In fact, the search showed that 201 patents issued on June 26, 2007 alone with the phrase "and/or" in the claims. Therefore, it is submitted that the phrase "and/or" is NOT indefinite and this rejection should be withdrawn.

Responses to Rejection of Claims – 35 U.S.C. §103

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu (U.S. Patent No. 5,983,369) (Bakoglu hereinafter) in view of Osborn et al (U.S. Patent No. 6,182,048) (Osborn hereinafter). These rejections are not applicable to the rejected claims.

Amended claim 1 is a method of upgrading the warranty of a computer system including a plurality of components in a configuration, comprising, among other things, receiving from a requestor a request to upgrade an existing warranty to cover a new configuration of the computer system; detecting, by the computer system, a configuration of the computer system;

determining if the configuration of the computer system is different than an original configuration of the computer system.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach receiving from a requestor a request to upgrade an existing warranty to cover a new configuration of the computer system; detecting, by the computer system, a configuration of the computer system; determining if the configuration of the computer system is different than an original configuration of the computer system as required by amended claim 1. To the contrary, Bakoglu relates to online computer support systems. See Background. Additionally, Osborn is limited to **NEW vehicle insurance policies**, not upgrading existing computer system warranties. See entire patent.

Referring to Bakoglu, the rejection states in page 3, paragraph 3 of the Office Action that "Bakoglu discloses a method of upgrading the warranty of a computer system including a plurality of components in a configuration." However, a quick search of the specification of Bakoglu reveals that Bakoglu is NOT disclosing warranty upgrades. For example, the only references found relating to the term "warranty" in Bakoglu are found in the Abstract, Col. 13, line 39, and claim 14. The reference in the Abstract relates to warranty information that is tracked and indexed, (i.e. nothing about a product warranty upgrade). The references in Column 13 and claim 14 relate to warranty validation. Again, nothing about a product warranty upgrade. Furthermore, the only references in the specification of Bakoglu relating to "upgrades" are found in Col. 1, line 53; Col. 8, line 15; Col. 13, lines 40 and 54; and claims 17 and 20.

Each of these references relate to *hardware* and/or *software* upgrades, NOT warranty upgrades.

The rejection additionally makes several references on page 3, paragraph 3 that Osborn discloses a warranty upgrade. However it is apparent from a review of Osborn that Osborn does NOT relate to product warranties. Rather, Osborn relates to *vehicle insurance*, commonly known as hazard insurance. In addition, to NOT disclosing a warranty as recited in the pending claims, Osborn does not even contain the word "upgrade" in the patent. Therefore, it is impossible for Osborn to disclose or teach a warranty upgrade as recited in the pending claims.

In view of the foregoing, it is apparent that each of the elements in the pending claims are not found in the references. Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to amended claim 1, and a rejection under 35 U.S.C. §103(a) is not applicable and should be withdrawn.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ___, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

In the present case, the Examiner has not expressed a reason why a person of ordinary skill in the art would combine the benefits of Bakoglu with the benefits of Osborn as required by the rejected claims. As described above, Bakoglu teaches online computer support systems. Osborn teaches NEW vehicle insurance policies. If the Bakoglu is combined with Osborn, as suggested by the Examiner, the result would not be a method of upgrading the warranty of a computer system including a plurality of components in a configuration, comprising, among other things, receiving from a requestor a request to upgrade an existing warranty to cover a

new configuration of the computer system; detecting, by the computer system, a configuration of the computer system; determining if the configuration of the computer system is different than an original configuration of the computer system, as is required by the claims. The elements recited by the pending claims cannot be achieved because the suggested combination would result in an online support system for NEW vehicle insurance policies. In view of the above, a person of ordinary skill in the art would not have a reason to combine Bakoglu with Osborn. Therefore, there is simply no basis for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 12, and 29 and their respective dependent claims are submitted to be allowable.

Claims 2 and 4 both depend from claim 1 and are allowable as depending from an allowable claim.

Claims 5, 6, 9, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Olarig et al (U.S. Patent No. 6,032,257) (Olarig hereinafter). Each of these claims depend directly or indirectly from independent claim 1. As shown above, independent claim 1 is allowable. Thus, these claims are allowable as depending from an allowable claim.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Wallis et al (U.S. Publication No. 2001/0051884) (Wallis hereinafter). Each of these claims depend indirectly from independent claim 1. As shown above, independent claim 1 is allowable. Thus, these claims are allowable as depending from an allowable claim.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu in view of Rajagopalan (U.S. Patent No. 6,934,686) (Rajagopalan hereinafter). This claim depends directly from independent claim 1. As shown above, independent claim 1 is allowable. Thus, this claim is allowable as depending from an allowable claim.

Claims 12, 14, 16, 22-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan. These rejections are not applicable to the rejected claims. Claims 12 and 29 are both independent claims that relate to methods for upgrading existing warranties, similar to independent claim 1. As described above relating to Osborn, Rajagopalan does not even contain the word "upgrade" in the patent. Thus, it is submitted that Rajagopalan only relates to NEW warranties, not warranty upgrades as recited in the pending claims. Therefore, it is impossible for Rajagopalan to disclose or teach a warranty upgrade as recited in the pending claims. Thus, it is apparent that each of the elements in the pending claims are not found in the references. Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to amended independent claims 12 and 29, and the rejection under 35 U.S.C. §103(a) is not applicable and should be withdrawn.

Claims 14 and 16 each depend directly or indirectly from independent claim 12 and are allowable as depending from an allowable claim. Claims 22-25 were previously cancelled and thus, this rejection is moot.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan, and further in view of Wallis. Each of these claims depend indirectly from independent claim 12. As shown above, independent claim 12 is allowable. Thus, these claims are allowable as depending from an allowable claim.

Claims 13 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan and further in view of Olarig. Each of these claims depend directly or indirectly from independent claim 12. As shown above, independent claim 12 is allowable. Thus, these claims are allowable as depending from an allowable claim.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan and further in view of Wallis. This claim depends directly from independent claim 12. As shown above, independent claim 12 is allowable. Thus, this claim is allowable as depending from an allowable claim.

Conclusion

This is an earnest attempt to put all pending claims in proper form for immediate allowance. The amendments to the claims are not meant to limit, but rather to further define the scope of the claims. The amendments are supported by the original application.

Independent claims 1, 12 and 29 and their respective dependent claims are submitted to be allowable. In view of at least all of the above. The allowance of all pending claims is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


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